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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,357	03/02/2004	Mark J. Antoine	25845.CON	8967

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EXAMINER

PHAN, THO GIA

ART UNIT PAPER NUMBER

2821

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/791,357

Applicant(s)

MARK ANTOINE

Examiner

Tho G. Phan

Art Unit

2821

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/12/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 and 21 of U.S. Patent No. 6,727,861. Although the conflicting claims are not identical, they are not patentably distinct from each other because the omission of an element or structure and its function in a combination is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson* 136 USPQ 184 (ccpa 1963). Claims 1-9 of the pending application, which eliminate elements "securing the mount to the soffit", and their function with the remaining elements functioning as before, are therefore merely an obvious variation of claims 1-15 and 21 of U.S. Patent No. 6,727,861. It would have been obvious for mounting a satellite dish to a soffit of a building for protecting the mounting bracket from the weather.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2, 6 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Pegues et al (6,195,066) [submitted by applicant].

Pegues et al in figures 1-8 disclose an apparatus comprising a base 15 for mounting to a structure 12, an elongate tubular member 18 attached to the base 15; an elongate arm 17 slidable with the tubular member 18 and having one end 25 thereof adapted for attaching to a satellite antenna dish assembly 11, and a lock 22,24 for detachably securing the elongate arm 17 to the tubular member 18, wherein the lock comprises a plurality of setscrews 22,24 operable within the elongate tubular member 18 for securing the elongate arm thereto (figures 3-4), wherein the tubular member 18 includes a bore extending fully therethrough (figures 3 and 4), and wherein the elongate tubular member 18 is integrally formed with the base 15.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2821

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pegues et al in view of Johnson (6,037,913) [both submitted by applicant].

Pegues et al have been discussed above but fail to teach the base includes opposing flange portions, and wherein the flange portions have the plurality of holes therein, a riser separating the elongate tubular member from the base and wherein the elongate arm includes a circular cross-section dimensioned for being closely received within the elongate tubular member having a circular cross-section bore therein. However, Johnson in figures 1-6 teaches a riser 33 separating the body portion 62 from the base portion (30/31/33), wherein the riser is attached to the base portion for providing opposing flange portions (two opposing flat sided portions of plate 31), and wherein the flange portions have the plurality of holes 32 therein, and wherein the elongate arm/tubular member includes a circular cross-section (column 6, lines 18-21). It would have been obvious design choice to provide the base includes opposing flange portions, and wherein the flange portions have the plurality of holes therein, a riser separating the elongate member from the base and wherein the elongate arm/tubular member includes a circular cross-section as taught by Johnson for the purpose of supporting the remaining elements of the antenna mount (column 4, lines 3-5).

***Allowable Subject Matter***

7. Claims 3 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims; and overcome the above "Double Patenting".

8. The following is a statement of reasons for the indication of allowable subject matter: The claims are allowable over the art of record because the prior art does not teach the rib and the elongate tubular member having a plurality of coincident threaded holes therethrough cooperating for receiving setscrews therein for securing the elongate arm to the tubular member (claim 3); wherein the opposing flange portions extend longitudinally along the elongate tubular member (claim 5).


***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patent to Troche is cited as of interested and illustrated a similar structure to a satellite antenna mounting device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tho G. Phan whose telephone number is 571-272-1826. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tho G Phan  
Primary Examiner  
Art Unit 2821